IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/740,584
Filing Date:	December 18, 2000
Applicant:	Jeffrey Morgan Alden et al.
Group Art Unit:	2815
Examiner:	Allan R. Wilson
Title:	AUTOMATIC RECONFIGURATION OF SYSTEM SUB-MODELS FOR INDEPENDENT ANALYSIS
Attorney Docket:	GP-301022

Mail Stop - Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

This is Appellant's Reply Brief filed in response to the Examiner's Answer mailed

June 26, 2009, please consider the following comments.

The Examiner states on page 4 of the Examiner's Answer that the following

terminology, "entities in the full model," "connecting arks," "isolated cycles," and "all

global variables" lack sufficient antecedent basis, thus rendering the various claims

indefinite under §112, second paragraph. The Examiner then goes on to state on page

7 of the Examiner's Answer that the §112, second paragraph, rejection is proper

because, "it is unclear whether the "entities" and the limitation "entities in the full model"

is referring to the "calculation entities" in line 5, or the "data entities" in line 6 in the same

claim. Regarding the "connecting arcs", isolated cycles", "all global variables", it is

unclear how the connecting arcs, isolated cycles, and all global variables are associated to the previous stated limitations in claim 1."

Appellant respectfully submits that the Examiner's reasoning is improper. As stated in Appellant's Brief, these various terminologies are not proceeded by the terms "said" or "the," and therefore, a rejection for antecedent basis is not proper. If the Examiner thinks that this language is indefinite for the reasons referred to above, then Appellant respectfully submits that the rejection is not one of lack of antecedent basis, but of indefiniteness generally. However, in order to satisfy that requirement for claims being indefinite, "the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 USC §112, second paragraph, by providing clear warnings to others as to what constitutes infringement of the patent," see MPEP 2173.02. Appellant submits that the claim language identified by the Examiner clearly satisfies this requirement.

Further, the Examiner must determine whether claim language is indefinite in light of the content of the particular application disclosure, the teachings of the prior art and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, also see MPEP 2173.02. Appellant respectfully submits that the Examiner has not analyzed Appellant's claims in view of these requirements, and thus, has improperly held Appellant's claims to be indefinite.

MPEP 2173.02 also states, "[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the meets and bounds of the claims so as to understand how to avoid infringement, a rejection of the claim under 35 USC §112, second paragraph, would be appropriate." Appellant submits that the claim language in

2

question clearly sets forth the meets and bounds of the claim so as to allow a person of ordinary skill in the art to avoid infringement.

The Examiner has cited the so called "mean-or-transformation test" of In re Bilski to hold that Appellant's method claims 1-12 are directed to non-statutory subject matter under 35 USC §101, which was not the test under section 101 over four years ago when Appellant first filed their Brief. The Examiner states that the limitations set forth in claims 1-12 "are a series of mental steps that can be done WITHOUT a machine or apparatus," and that "claims 1-12 do not state any limitations in regards to particular machine or apparatus, therefore, claims 1-12 fail this test."

Appellant respectfully submits that the Examiner's unequivocal statement that the limitations in claims 1-12 ARE a series of mental steps is without basis and is improper. Appellant questions just how a person of ordinary skill in the art could possibly perform the series of claimed mental steps of defining a sub-model as a collection of entities in a visual medium, determining which of the entities in the sub-model are calculation entities and which are data entities, converting the calculation entities in the sub-model that depend on entities in the full model that are not included in the sub-model into temporary data entities, identifying output entities in the sub-model, where the output entities are calculation entities that do not have an output to another entity, and visually analyzing changes in the sub-model in response to performing the calculations for the calculation entities, were visually analyzing changes in the sub-model includes analyzing changes in the size of at least one data entity. Appellant respectfully submits that it just does not seem possible that a person could perform these steps mentally. The very bright person that could perform those steps mentally would also have to mentally perform all of the limitations of dependent claims 2-7 under the Examiner's reasoning.

Further, visually analyzing changes in the sub-model isn't a mental step, but is a visual step that requires eyes. Also, if the limitations in claims 1-12 ARE a series of mental steps, then why does Appellant provide figures 1, 2, 4, 5, 7-9 and 11 that represent visual things and why does Appellant refer throughout the specification to various computer protocols, spreadsheets, algorithms, software, etc. to be used to perform the method of the invention.

The Examiner also states, as discussed above, that the limitations of claims 1-12 can be done without a machine or apparatus. Appellant respectfully submits that this is incorrect because the claimed invention requires defining the sub-model as a collection of entities in a visual medium and visually analyzing changes in the sub-model including analyzing changes of the size of at least one of the data entities. Appellant submits that the visual medium would be part of some type of machine or apparatus. Further, the sub-model is part of a full system model, where the term "system" implies something or an apparatus.
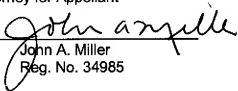
In view of the foregoing and the discussion in Appellant's Brief, it is respectfully requested that the Examiner's rejections be reversed.

Applicant is filing concurrently herewith, a Power of Attorney to Prosecute Applications before the USPTO (appointing practitioners associated with the Customer

No. 65798 Power of Attorney and changing the Correspondence Address as associated

with Customer No. 65798 as identified below) along with a Statement under 37 CFR

3.73(b).

Respectfully submitted,
MILLER IP GROUP, PLC
Attorney for Appellant

By: _John A. Miller_
John A. Miller
Reg. No. 34985

Dated: _8/19/09_
42690 Woodward Ave., Ste. 200
Bloomfield Hills, MI 48304
Telephone: (248) 858-4200
Facsimile: (248) 858-4201